

This Page Is Inserted by IFW Operations  
and is not a part of the Official Record

## **BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning documents *will not* correct images,  
please do not report the images to the  
Image Problem Mailbox.**

06110104

AF/3679/ \$ Ifu



I hereby certify that this paper and a fee are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above, addressed to MAIL STOP APPEAL BRIEFS-PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on the 8<sup>th</sup> day of June, 2004.

*Ray R. Regan*  
Ray R. Regan, Registration No. 36,899

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

|                            |                  |
|----------------------------|------------------|
| In re Application of:      | Steve B. Taylor  |
| Sole Inventor:             | Steve B. Taylor  |
| For:                       | A Coupler        |
| Filing Date:               | June 20, 2003    |
| Application Number:        | 10/600,379       |
| Attorney Docket Number:    | 2236.001         |
| Express Mail Label Number: | ER813736983US    |
| Group Art Unit:            | 3679             |
| Examiner:                  | Victor MacArthur |

**APPELLANT'S APPEAL BRIEF**

To: Mail Stop APPEAL BRIEFS-PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Honorable Members of the Board:

As provided in 37 C.F.R. §1.192, Appellant files this Appeal Brief in triplicate in connection with the above-identified application with the Board of Patent Appeals and Interferences ("Board").

The requisite government fee provided for in 37 C.F.R. §1.17(c) for a small entity in the amount of \$165.00 for filing this Appeal Brief is enclosed.

06/14/2004 JADD01 00000122 10600379

01 FC:2402

165.00 OP

The Commissioner hereby is authorized to charge any additional fees to Account Number 501565 for the Law Office of Ray R. Regan, P. A., and to deposit any overpayments to Account Number 501565.

**(1) Real Party in Interest**

The real party in interest is the Appellant, Steve B. Taylor, an individual, whose mailing address is 4908 Hawkins, N.E., Albuquerque, New Mexico 87109, and whose residence address is 9718 Avenida del Oso, N.E., Albuquerque, New Mexico 87111.

**(2) Related Appeals and Interferences**

5 No other appeals or interferences will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

**(3) Status of Claims**

Claims 1-22 are pending in the application. Claims 23-31 have been withdrawn from consideration as being directed to a non-elected species.

Claims 1-22 have been finally rejected.

Prosecution History: Appellant filed the original application on June 20, 2003. The Examiner entered a telephonic restriction, with traverse, and limited examination of the Application to claims 1-22. The Examiner thereafter mailed a first, non-final office action on February 23, 2004 ("First Office Action"). Appellant filed a Reply on March 19, 2004 ("First Reply of Applicant"). In response, the Examiner entered a Final Office Action on May 6, 2004 ("Final Office Action"). Appellant filed a Notice of Appeal to the Board on June 2, 2004.

As stated in Section (9) of this Brief, the appealed claims are set forth in **Appendix A**.

**(4) Status of Amendments**

Appellant filed no claim amendments in response either to the First Office Action, or to the Final Office Action,

**(5) Summary of the Invention**

As stated in independent claims 1 and 11 (see Claims in Appendix A of this Appeal Brief), and as further shown both in the specification of the Application at pages 1-2 and in drawing Figures 1-14, the coupler disclosed and claimed in the Application pertains generally to installing load-bearing shafts on variously shaped surfaces.

Because boat hulls are commonly curved, rather than straight or planar, in at least the boating industry an unsolved problem exists for mounting shafts, towers, and other devices (collectively, “equipment”) on boat hulls. See Application, page 1, lines 20-29, and page 2, lines 1-15.

Suggested solutions (a) require mounting equipment in a single position only, or (b) mounting the equipment with limited movement. Other solutions require modifying the shape of a boat hull to accommodate mounting the equipment. No solution provides an apparatus mountable intermediate the curved surface of a boat, and the equipment to be mounted on the boat, that accommodates flat-surfaced equipment and curved surfaces, and allows installation of the equipment in a variety of positions.

Accordingly, Applicant invented the new and useful invention claimed in the Application, namely a variably positionable coupler mountable on a curved surface, and capable of securing equipment in a variety of positions. See Application, page 1, lines 20-29, and page 2, lines 1-15, and the claims in Appendix A.

#### **(6) Issues**

Whether claims 1-3 are patentable because U.S. Patent No. 5,697,320 issued to Murray on December 16, 1997 (“Murray Patent”) does not anticipate the claims under 35 U.S.C. §102(b).

Whether dependent claim 4 is patentable because, under 35 U.S.C. §103(a), the claim is not obvious over the Murray Patent in view of U.S. Patent No. 5,704,749 issued January 6, 1998 to Landgrebe (“Landgrebe Patent”).

Whether dependent claim 5 is patentable because, under 35 U.S.C. §103(a), the claim is not obvious over the Murray Patent in view of the Landgrebe Patent, in further view of U.S. Patent No. 1,257, 536 issued to Schroeder on February 26, 1918 (“Schroeder Patent”).

Whether claims 6-13 and 16-22 are patentable because, under 35 U.S.C. §103(a), the claims are not obvious over the Murray Patent in view of the Schroeder Patent.

Whether dependent claims 14-15 are patentable because, under 35 U.S.C. §103(a), the claims are not obvious over the Murray Patent in view of the Schroeder Patent, and in further view of the Landgrebe Patent.

### **(7) Grouping of Claims**

The rejected claims are grouped as follows: Claims 1-10 and 11-22, which stand or fall together.

### **(8) Arguments**

#### **Predicate Argument Applicable to All Rejections in the Final Office Action**

As a predicate comment applicable to all rejections in the Final Office Action, it seems appropriate to consider the problem of burgeoning analytical differences among those involved with the patenting process, differences that are leading to a corresponding escalation in the number of appeals.

During the past decade, decisions emanating from the U.S. Supreme Court, the Court of Appeals of the Federal Circuit, and arguments advanced by the examining cadre in the Patent Office, often seem at odds with (i) the Manual of Patent Examining Procedure (“MPEP”), (ii) the consistent holdings of the Board, and (iii) the understanding of patent practitioners.

There is, of course, the “Festo Factor.” Regardless of how the ten decisions now classified as “Festo” are read or interpreted, one rule looms clearly: any amendment made during prosecution assures later challenge as having been made “for purposes of patentability.” Because almost any claim amendment may prospectively be recast as having been entered “for purposes of patentability,” practitioners now are advised that the Supreme Court has established “amendment and appeal as opposite paths to be taken.” In other words, one must always appeal, rather than amend claims. *See Appealing a Rejection at the Board: Analysis of Recent Board Decisions and Non-Appeal Alternatives*, Susan Perng Pan, *Journal of the Patent and Trademark Office Society*, Vol. 85, No. 11 (November, 2003), page 853, at 855 *et seq.* As required by MPEP §1206, a copy of the article is included with this Brief at **Appendix B**.

In addition to dilemmas posed by the Festo Factor, the examining cadre occasionally invokes arguments of the kind found in this case, arguments that contrary to the admonitions in the MPEP, raise the specter of an adversarial proceeding, rather than an *ex parte* effort to achieve patentability. On page 3 of the Examiner’s Final Office Action the Examiner argues:

(Note that while the Murray curved surface does not curve at its point of contact with element 40, it does curve elsewhere and is thus a curved surface within the broadest reasonable interpretation of the claim language.)

The Examiner's argument seems to be this: Although Applicant's arguments are valid, they are irrelevant because the Examiner may reject claims based on the "broadest reasonable interpretation of claim language." The corollary to that argument seems to be: During examination, no regard need be paid to the specification, its definitions, and its explanations.

Two problems present themselves: First, if neither the definitions nor explanations provided in the specification of a patent application have meaning, why are they included?

Second, the argument that the examiners need consider only the "broadest reasonable interpretation of claim language" is wrong. The assertion is inconsistent with the MPEP rules of prosecution claim interpretation. MPEP §2111.01 does not state that pending claims must be given their broadest reasonable interpretation. Rather, that section clearly requires that "...pending claims must be given their broadest reasonable interpretation **consistent with the specification.**"

Those four words, "consistent with the specification," significantly modify the rule.

In fact, the "broad interpretation" formulation goes on to indicate that "broad" interpretation is not the goal. MPEP §2111.01 states that "...broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified." In other words, an examiner should indeed read the claims "in light of the specification," but should not read limitations into a claim.

Clearly, therefore, claims are not to be examined by giving them their broadest possible interpretation. Rather, pending claims are to be given their broadest reasonable interpretation consistent with the specification. That is logical; claims are not drafted in a vacuum, but are shaped, defined, and given meaning by the specification of the application.

Fortunately, the Board is in agreement. Although not binding precedent, the analytical approach taken in recent decisions supports the foregoing analysis: *Ex parte* Cynthia L. Cassel, *et al.*, Appeal No. 2002-1893 pertaining to Application No. 09/767,413, and *Ex parte* Kyle D.

Wessells, *et al.*, Appeal No. 2004-0462 pertaining to Application No. 09/915,861. In both cases, the Board gave due consideration not only to the claims, but did so in light of the specification.

The Festo Factor raises the specter that any claim amendment may be considered suspect, and may be deemed to eliminate application of the Doctrine of Equivalents, when reviewed by a court during infringement litigation. Frequently, however, claim amendments are unnecessary if the guidance of the MPEP is properly applied during examination. In this case, it seems that the examiner began with an erroneous perception about MPEP §2111.01, which, if corrected by this Board, will result in issuance of letters patent without amendment of the claims.

In light of that background, Appellant will now address each argument advanced by the Examiner in this case.

#### **Rejection Under 35 U.S.C. § 102(b)**

Claims 1-3 are patentable because they are not anticipated under 35 U.S.C. §102(b) by U.S. Patent No. 5,697,320 issued to Murray on December 16, 1997 ("Murray Patent").

The coupler was neither patented nor described in a printed publication in this or a foreign country, nor was it in public use or on sale in this country, more than one year prior to the date of filing of the Application in the United States.

Claims 1-3 are, therefore, allowable as originally filed because the cited reference does not anticipate Applicant's coupler.

Applicant's coupler as claimed in independent 1 is directed, among other things, to an apparatus that includes structural elements that differ markedly from those claimed in the Examiner's primary reference, the Murray Patent. The structural elements of Applicant's coupler also cooperate differently than those claimed in the cited reference. Accordingly, the Examiner should have withdrawn the rejections of claims 1-3.

Specifically, as recited in claim 1, Applicant's coupler is variably positionable. The coupler includes a base having a flat planar surface on the lower side but is, nevertheless, mountable on a curved surface, a unique and novel contribution to the art, because means are provided for mounting the base on a curved surface. In one embodiment of the coupler, the means for the mounting the coupler on a curved surface is a plurality of ball washer assemblies. The structural elements comprising the ball washer assemblies are identified in the specification,

the drawing figures, and claims. See Application, page 7, beginning at line 5, and claims 16-18, Application, page 14, beginning at line 10. Additionally, the coupler includes a structural element described as a tub. The tub cooperates with the base by being, as claimed, adjustably connectable to the base. A structural element described as a plug is provided. The plug cooperates with the tub by being repositionably attachable to the tub. In addition, the coupler includes a structural element identified as a neck. The neck is rotatably insertable in the plug. Further, the neck is formed for securing a shaft to the neck. A clevis mechanism, slidably and demountably engageable with the plug and the neck, also is included. See Application, page 12, lines 5-13.

The Murray Patent discloses neither the structure nor cooperation of structure of Applicant's coupler.

In the Final Office Action, the Examiner provides "marked up" figures 4 and 5 extracted from the Murray Patent. The Examiner added reference numbers 100 and 200 to the marked up figures. The Examiner suggests that the Murray Patent discloses "...means (57) for mounting the base on a curved surface...." Applicant respectfully disagrees.

Item 57 of the Murray Patent is not even mentioned in the specification of the Murray Patent. It appears that the lead line to item 57 is directed to a hole or bore. Neither the hole nor bore would provide the means for mounting the base on a curved surface provided by Applicant's coupler. Neither the hole nor bore comprise a plurality of ball washer assemblies as claimed by Applicant.

The Examiner also asserts on page 4 of the Office Action that the Murray Patent discloses "...a tub (100) adjustably connectable to the base...." The structural element marked by the Examiner in Figure 4 as item 100 is the same or similar to item 55 in Figure 5. But the specification of the Murray Patent identifies item 55 as "...an eyelet fitted on the end of the leg...." See Murray Patent, col. 5, ll. 12-14.

The Examiner then argues that the Murray Patent provides a structural element comparable to plug 72 of Applicant's coupler. The Examiner states that the Murray Patent discloses "...a plug (42, 71) repositionably attachable to the tub." Applicant respectfully disagrees. The Examiner seems to suggest that the plug of Applicant's coupler can be achieved



by combining items 42 and 71 of the Murray Patent. But Marked-up Figure 4 on page 4 of the Office Action indicates that element 42 is a shaft or, in the words of the Murray Patent, a “leg portion 42....” See Murray Patent, col. 3, ll. 51. Item 71, however, collectively are “T-fitting 71 slides...that are extensions of “camel back hinges 40....” Neither alone nor in combination can elements 42 and/or 71 be said to repositionably attachable to a tub, as described and claimed in claim 1 of the Application, or can be said to provide for rotatable insertion of the neck as disclosed and claimed in the Application. See Application, Figure 2; and see Murray Patent, col. 4, ll. 11-14 and col. 3, ll. 48-49.

As shown above, pending claims are to be given their broadest reasonable interpretation consistent with the specification.

The specification shows that tub 70 of boom-swivel device 68 includes a chamber 76. Chamber 76 defines a wall that, in a preferred embodiment of the present invention, forms circumferential wall 78. In addition, opposing threaded hollow holes 80a,b are formed in wall 78 of tub 70. Opposing threaded hollow holes 80a,b as well as through opposing apertures 20a,b in opposing yokes 18a,b are engageable by first threaded bolts 22a,b . See Application, page 8, lines 5-12.

The specification also shows, by cross-reference among Figures 3, 5 and 11A-11C, that plug 72 that is formed with a body 82. Body 82 of plug 72 is formed with a leading end 84 and a following end 86. In addition, a disk 88 is monolithically formed and positioned on leading end 84 of plug 72. Disk 88 of body 82 is removably insertable into chamber 76 of tub 70 both for positioning purposes and for allowing plug 72 to be rotatably insertable around a longitudinal axis through chamber 76 in tub 70. A groove 90 is formed in body 82 of plug 72. The formation of groove 90 contributes to defining opposing arms 92a,b in body 82 of plug 72. In addition, opposing hollow tubes 94a,b are formed in opposing arms 92a,b of body 82 of tub 70. Groove 90 in body 82 is dimensioned for insertion of neck 74. Opposing tubes 94a,b in opposing arms 92a,b are included in a preferred embodiment of the present invention for insertion of a clevis mechanism 96 as described subsequently in this document. See Application, page 8, lines 13-24.

Neither the foregoing structure, nor the foregoing cooperation of structure, is shown or claimed in the Murray Patent.

The Examiner also argues that the Murray Patent discloses a structural element akin to neck 74 of Applicant's coupler: the Examiner states that "...a neck (55) [is] rotatably insertable in the plug, wherein the neck is formed for securing a shaft 200 to the neck...." See Office Action, pages 4-5. Applicant respectfully disagrees. The Murray Patent discloses no structural element comparable to neck 74 of Applicant's coupler. The item that the Examiner identifies as "neck (55)" has already been identified by the Examiner as tub (100). In Applicant's coupler, neck 74 is rotatably insertable in plug 72. Accordingly, the element advanced by the Examiner as a "neck" is certainly not rotatably insertable in the plug.

The Examiner concludes the arguments about claim 1 of Applicant's coupler by the following assertion: "Note that while the Murray curved surface does not curve at its point of contact with element 40 [i.e., the camel back hinges noted above], it [presumably the 'curved surface'] does curve elsewhere and is thus a curved surface with the broadest reasonable interpretation of the claim language." See Office Action, page 5. Applicant is unclear as to the Examiner's assertion. First, Applicant's coupler includes a base having a flat planar surface on the lower side that is, nevertheless, mountable on a curved surface. This unique and novel contribution to the art is both claimed and shown in Figures 3 and 4. Second, Applicant makes no claim that any element of the coupler has a curved surface. Third, the Examiner does not identify where the "elsewhere" is that shows that "it" curves.

As claimed, Applicant's coupler is variably positionable. The device disclosed in the Murray Patent is not. At best, the Murray device can move in one plane. More specifically, using the terms of the Murray Patent, when T-fitting 71, as shown in Figure 5, is mounted on eyelet 55, the device can move only rotationally around a single point in an x-y axis. Applicant's coupler, however, is variably positionable.

In summary, the Murray Patent neither claims nor discloses, the coupler disclosed in the specification of the Application, and claimed by Applicant.

For these reasons, and for the reasons articulated below, Applicant respectfully requests that the rejections of claims 1-3 under 35 U.S.C. §102(b) be withdrawn.

### Discussion of Rejections under 35 U.S.C. §102

The fundamental teaching on the doctrine of anticipation was set forth by Judge Rich in *In re William J. King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986):

It is axiomatic that anticipation of a claim under §102 can be found only if the prior art reference discloses every element of the claim.

*In re William J. King* at 231 USPQ 139 (emphasis added).

Further, as provided in MPEP §2131, for a reference to anticipate a claim, that reference must teach, or identically describe, each and every element or step of the claim in the identical orientation. *Atlas Powder v. E.I. duPont*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *Jamesbury Corp. v. Litton Industrial Products*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985) (emphasis added). “Anticipation” is a restrictive concept, requiring the presence in a single prior art disclosure of each and every element of a claimed invention. Further, as held in *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991), “there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” (Emphasis added)

As discussed above, the Murray Patent does not disclose the identical structure and cooperation of structure as described in the Application.

Applicant, therefore, respectfully urges that the Murray Patent does not anticipate claims 1-3 of Applicant's coupler as claimed, and that those rejections be withdrawn.

### First Rejection Under 35 U.S.C. § 103(a)

The Examiner expressly rejected dependent claim 4 as obvious, but claim 4 is patentable because, under 35 U.S.C. §103(a), the claim is not obvious over the Murray Patent in view of U.S. Patent No. 5,704,749 issued January 6, 1998 to Landgrebe (“Landgrebe Patent”).

Incorporating by reference all foregoing statements recited in this paper, Appellant also submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Claim 4 is a dependent claim. Having overcome the rejections of independent claim 1, dependent claim 4 is allowable for at least the same reasons that support allowability of independent claim 1.

Further, as succinctly stated in the MPEP, to establish a *prima facie* case of obviousness, three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference or to combine the teachings in the cited references; (2) a reasonable expectation of success; and (3) the cited references must teach or suggest all the claim limitations. See MPEP §706.02(j). The cited reference “must expressly or impliedly suggest the claimed invention....”

As provided in MPEP §2143.01, the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

Also, and rather significant in this instance, Applicant’s disclosure should not be used as a blueprint to reconstruct the claimed coupler out of isolated teachings in the prior art. *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir., 1988).

Although the Examiner argues on page 6 of the Office Action that “it would have been obvious to modify the coupler of Murray to include, (sic.) frustoconical recesses, as taught by Landgrebe, for the purpose of improving fastener alignment during assembly,” the Examiner points to no suggestion, no motivation, no teaching recited in either reference to support the argument.

Further, although the Examiner asserts that it would be permissible to modify the coupler by incorporating features of the Landgrebe Patent, Applicant respectfully submits it is improper to modify the coupler utilizing the reference. See MPEP §2143.01, the heading of which states that “The Proposed Modification Cannot change the Principle of Operation of a Reference.”

To combine the references in the manner sought by the Examiner is an application of impermissible hindsight in the analysis of Applicant’s novel coupler, and would require impermissible modification of the principles of operation of Applicant’s coupler.

**Second Rejection Under 35 U.S.C. § 103(a)**

Claim 5 is patentable because under 35 U.S.C. §103(a) the claim is not obvious over the Murray Patent in view of the Landgrebe Patent, in further view of U.S. Patent No. 1,257, 536 issued to Schroeder on February 26, 1918 ("Schroeder Patent").

Incorporating by reference all of the foregoing statements recited in this paper, Appellant also submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Claim 5 also is a dependent claim. Having overcome the rejection of independent claim 1, dependent claim 5 is allowable for at least the same reasons that support allowability of independent claim 1.

Although the Examiner argues on page 6 of the Office Action that "it would have been obvious...to adapt the means for mounting, as taught by Schroeder, to be used at each hole of the Murray means for mounting," once again the Examiner points to no suggestion, no motivation, no teaching recited in either reference to support such an argument.

Additionally, it seem evident that the Schroeder Patent is intended to be deployed only in connection with flat surfaces, not curved surfaces. See Schroeder Patent, Figures 1 and 2, and col. 2, ll. 64-80 for an explanation of that inventor's recommended use of the Schroeder device on first "a horizontal body portion," and second, on a "vertical portion." Unlike the variably positionable coupler claimed and disclosed by Applicant, to reverse the Schroeder device from a horizontal to a vertical orientation, bolt 10 must be removed and reinserted "sideways." See Figures 1 and 2.

**Third Rejection Under 35 U.S.C. § 103(a)**

Claims 6-13 and 16-22 are patentable because under 35 U.S.C. §103(a) the claims are not obvious over the Murray Patent in view of the Schroeder Patent.

Incorporating by reference all of the foregoing statements recited in this paper, Applicant also submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have

been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Claims 6-10 are dependent from independent claim 1.

As Applicant already has indicated, having overcome the rejections of independent claim 11 by showing that the primary reference of the Examiner, namely the Murray Patent, does not anticipate Applicant's coupler, dependent claims 6-10 are allowable for at least the same reasons that support allowability of independent claim 11.

The Examiner rejected independent claim 11 for obviousness.

Independent claim 11, however, claims a boom-swivel device 68 that is detachably fixable to base 12. The claims dependent from independent claim 11, and the specification of the Application, show that boom-swivel device 68 includes at least one tub 70 (see claim 19), a plug 72 (see claim 20), and a neck 74 (see claim 21). Applicant incorporates by reference all arguments made in this paper in connection with those elements of the coupler, and submits that Applicant has overcome the rejection of the Examiner. As to the rejection for obviousness the Schroeder Patent, Applicant has already overcome any application of that reference to Applicant's coupler, and further submits for the Examiner's consideration that there is neither a suggestion or motivation recited in either reference to combine elements in the novel manner of Applicant's coupler, nor any teaching of all the claim limitations. Accordingly although the Examiner argues on page 8 of the Office Action that "it would have been obvious...to adapt the washer assembly, as taught by Schroeder, to be combined with each hole of the Murray means for mounting...", the Examiner points to no suggestion, motivation, or teaching recited in either reference to support the argument.

In addition, Schroeder offers no teaching or suggestion that the Schroeder device is mountable on a curved surface. Attempting to combine the elements of the Murray Patent with the elements of the Schroeder Patent would result in an assembly that certainly would not be stationary on a curved surface, and could rotate only in one plane. Contrary to the Examiner's argument, the Schroeder ball washer assembly is not "beneficial for mounting components in a variety of positions," but rather only on a horizontal or planar position. See Office Action, page 8.

Claims 12-13 and 16-22 are dependent from independent claim 11. As Applicant has indicated, having overcome the rejections of independent claim 11 by showing that the primary reference of the Examiner, namely the Murray Patent, does not apply, dependent claims 16-22 are allowable for at least the same reasons that support allowability of independent claim 11.

#### **Fourth Rejection Under 35 U.S.C. § 103(a)**

Claims 14-15 are patentable because under 35 U.S.C. §103(a) the claims are not obvious over the Murray Patent in view of the Schroeder Patent, and in further view of the Landgrebe Patent.

Incorporating by reference all of the foregoing statements recited in this paper, Applicant also submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Claims 14-15 depend from independent claim 11.

As Applicant already has indicated, having overcome the rejections of independent claim 11 by showing that the primary reference of the Examiner, namely the Murray Patent, does not apply, dependent claims 14-15 are allowable for at least the same reasons that support allowability of independent claim 11.

Nothing in any of the cited references suggests or teaches the modifications or combinations argued by the Examiner.

#### **Discussion of Rejections under 35 U.S.C. §103**

For the Examiner to establish a *prima facie* case of obviousness based on a combination of the content of various references, “there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant.” *In re Creg W. Dance v. Hoek et al.*, (CAFC, 97-1229, October 30, 1998), citing *In re Raynes*, 7 F.3d 1037, 1039, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992), emphasis added.

“Obviousness cannot be established by hindsight combination to produce the claimed invention.” *In re Creg W. Dance v. Hoek et al.*, (CAFC, 97-1229, October 30, 1998), citing *In re*

*Gorham*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

Contrary to the Examiner's goal in this case, to modify Appellant's invention as shown in the Examiner's "marked up" figures, to modify a prior art reference to render a patent obvious requires that "the prior art suggested the desirability of the modification." *In Re Fitch*, 23 USPQ2d 1784 (Fed. Cir. 1992). There is nothing in the cited reference or references that suggest the desirability of the proposed modification.

It is also clear that a reference teaches away from an invention when "it suggests that the line of development flowing from the references's disclosure is unlikely to be productive of the result sought by the applicant." *In re Gurley*, 27 Fed. 3rd 551, 553, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994). In reading such a reference, explained the court, the Examiner must ask if a person of ordinary skill in the art would have been discouraged from following the path set out in the reference, or "would [have been] led to a direction divergent from the path taken by the applicant." *In re Gurley*, at 1131. In other words, teaching away is the antithesis of suggesting that a person of ordinary skill in the art proceed in the direction taken by the applicant.

The references cited do not even consider mounting a flat, planar device on a curved surface. The references include no suggestion at all that a person should consider what the Appellant invented.

In determining the scope and content of the prior art, references must be read in their entirety, which means "as a whole." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ 2d 1593, 1597 (Fed. Cir. 1987). More, plural references cited in combination by the Examiner must be considered for all they disclose, including disclosures that teach away from an invention, as well as those that point toward it. *Panduit Corp.*, 810 F.2 at 1568, 1 USPQ 2d at 1597. Singular references, selected to support an allegation that the structure and cooperation of structure of the invention disclosed in an application are merely matters of design technique or design choice, must still satisfy the burden on the USPTO to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. *In re Reuter*, 651 F.2d 751, 210 USPQ 249 (CCPA 1981).

In view of these ageless references about what is "obvious" under 35 U.S.C. §103, Appellant respectfully urges that the claims be allowed. The structure as both disclosed in the Application, and claimed, differs from the structure disclosed in the references. The references



cited by the Examiner do not disclose the cooperation of structure of Applicant's coupler. The references disclose no teaching or suggestion to support the notion that the coupler is obvious in view of the combination of references cited by the Examiner.

**Conclusion**

In view of the foregoing, Appellant respectfully requests that the honorable Board of Patent Appeals and Interferences overrule the Final Rejection of Claims 1-22 over the cited art, and hold that Appellants' Claims 1-22 are allowable over the references.

**(9) Appendix**

The claims involved in this appeal are attached as Appendix A.

Respectfully submitted,

LAW OFFICE OF RAY R. REGAN, P.A.

By: 

Ray R. Regan, Reg. No. 36,899

For Appellant

P. O. Box 1442

Corrales, New Mexico 87048

Telephone (505) 897-7200

Facsimile (505) 897-7201

E-mail rayregan@rayrregan.com



**APPENDIX A**  
**to Appeal Brief of Appellant**

1. (Original) A variably positionable coupler mountable on a curved surface, comprising:  
a base formed with an upper side and a lower side,  
wherein the lower side is a substantially flat planar surface;  
means for mounting the base on the curved surface;  
a tub adjustably connectable to the base;  
a plug repositionably attachable to the tub;  
a neck rotatably insertable in the plug,  
wherein the neck is formed for securing a shaft to the neck; and  
a clevis mechanism slidably and demountably engageable with the plug and the neck.
2. (Original) A variably positionable coupler mountable on a curved surface as recited in claim 1, further comprising opposing yokes monolithically extending at substantially right angles from the upper side of the base.
3. (Original) A variably positionable coupler mountable on a curved surface as recited in claim 2, further comprising one or more bores formed in the base with a proximal end and a distal end, and further wherein the one or more bores are shaped for removable engagement with a bolt.
4. (Original) A variably positionable coupler mountable on a curved surface as recited in claim 3, further comprising a frustoconical recess formed adjacent the proximal end of the one or more bores.
5. (Original) A variably positionable coupler mountable on a curved surface as recited in claim 4, further comprising a concave cup formed adjacent the distal end of the one or more bores.
6. (Original) A variably positionable coupler mountable on a curved surface as recited in claim 1, wherein the mounting means is a plurality of ball washer assemblies.

7. (Original) A variably positionable coupler mountable on a curved surface as recited in claim 6, wherein the plurality of ball washer assemblies includes a second threaded bolt formed with a first diameter.
8. (Original) A variably positionable coupler mountable on a curved surface as recited in claim 7, wherein the plurality of ball washer assemblies includes a ball washer.
9. (Original) A variably positionable coupler mountable on a curved surface as recited in claim 8, wherein the ball washer is formed with a substantially hemispherical exterior surface, an interior surface, and a duct between the substantially hemispherical exterior surface and the interior surface formed with a second diameter larger than the first diameter of second threaded bolt.
10. (Original) A variably positionable coupler mountable on a curved surface as recited in claim 9, further comprising a nut assembly.
11. (Original) A coupler system, comprising:
  - a base formed with opposing yokes;
  - means formed in the base for mounting the base on a curved surface;
  - a plurality of ball washer assemblies combinable with the mounting means; and
  - a boom-swivel device detachably fixable to the base for securing a shaft to the coupler system.
12. (Original) A coupler system as recited in claim 11, wherein the opposing yokes are formed with opposing apertures.
13. (Original) A coupler system as recited in claim 11, wherein the mounting means includes a bore formed in the base.

14. (Original) A coupler system as recited in claim 13, wherein the mounting means includes a recess formed in one end of the bore.
15. (Original) A coupler system as recited in claim 14, wherein the mounting means includes a cup formed in the other end of the bore.
16. (Original) A coupler system as recited in claim 11, wherein the plurality of ball washer assemblies includes a bolt formed with a first diameter.
17. (Original) A coupler system as recited in claim 16, wherein the plurality of ball washer assemblies includes a ball washer formed with a duct having a second diameter larger than the first diameter of the bolt.
18. (Original) A coupler system as recited in claim 11, wherein the plurality of ball washer assemblies includes a nut assembly.
19. (Original) A coupler system as recited in claim 11, wherein the boom-swivel device includes at least one tub adjustably connectable to the opposing yokes.
20. (Original) A coupler system as recited in claim 11, wherein the boom-swivel device includes a plug repositionably attachable to the tub.
21. (Original) A coupler system as recited in claim 11, wherein the boom-swivel device includes a neck for supporting a shaft rotatably insertable in the plug.
22. (Original) A coupler system as recited in claim 11, wherein the boom-swivel device includes a clevis mechanism engageable with the plug and the neck.



**APPENDIX B**  
**to Appeal Brief of Appellant**

# Journal of the Patent and Trademark Office Society



*A medium of expression for the exchange of thought in the fields of Patents, Trademarks and Copyrights; a forum for the presentation and discussion of legal and technical subjects relating to the useful arts; a periodical for the dissemination of knowledge of the functional attributes of the patent, trademark, and copyright laws, in order to effect a more uniform practice thereof and through which all interested in the development and appreciation thereof may work to a common end.*

*Published Monthly by members of the Patent and Trademark Office Society*

Louis S. Zarfaz, Editor-in-Chief  
Tariq Hafiz, Business Manager  
Greg Huson, Subscription Coordinator  
Larry Schwartz, Subscription Coordinator

Karin Tyson, Assistant Editor  
Bo Bounkong, Advertising Manager  
John Mielcarek, Subscription Coordinator

Fred Silverberg (Ch.)  
Board of Governors  
William Neuder

Maura Regan

Society Officers

Meredith Petravick, President

Anne Marie Boehler, Vice President

*Imaging for every Dimension*

## Patents & Link

1-888-445-3729  
WWW.PATENTSLINK.COM

**Patent**

- Formal Drawings via E-mail
- Private On-Line Drawing Archive
- Foreign Filings
- CAD Conversions
- Error-Free Commitment
- Always On Time

**Litigation Support**

- Static Mounted Displays
- 2D Animations
- 3D Animations
- Multimedia Presentations
- Clear, Creative and Captivating Simulations

---

## Notes from the Editor

**T**his month we look at Appeals and Alternatives, Foreign-filed PCTs, and Traditional Knowledge and the New Mercantilism.

Susan Pan explores recent Board decisions versus continuing *ex parte* prosecution.

Sean Passino, Stephen Maebius and Hal Wegner analyze an asymmetry introduced by the ASPA with respect to foreign language-filed PCT applications.

Lastly, we conclude with the final installment of Shubha Ghosh's fascinating treatise on the tricky interface between traditional knowledge and contemporary IP protection.

That's all from here,  
Louis S. Zarfas  
Editor-in-Chief

---

## Appealing a Rejection at the Board: Analysis of Recent Board Decisions and Non-Appeal Alternatives

Susan Perng Pan<sup>1</sup>

### ABSTRACT

**T**his article discusses the merits of appealing rejections to the Board of Patent Appeals and Interferences in comparison to continued *ex parte* prosecution before the Examiner. The analysis takes into account recent decisions rendered by several patent panels and recent precedent of the Court of Appeals for the Federal Circuit. Recommendations are offered to place claims in better condition for appeal, types of arguments to be made and potential pitfalls to guard against.

### I. TIMING FOR APPEAL

The timelines for Appeal and *ex parte* prosecution become intertwined because the U.S. patent statute permits appeal of a rejection in the following circumstances.

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.<sup>2</sup>

In implementing the statute, the patent office regulations permit an Applicant to appeal a rejection in an application for original patent either

---

<sup>1</sup> The author is a partner of Sughrue Mion, PLLC, Washington, D.C. Ms. Pan's practice includes litigation and extensive *ex parte* prosecution and appellate practice. The view expressed herein are solely those of the author.

<sup>2</sup> 35 U.S.C. § 134(a) (2000).



after receiving a final rejection or after two non-final rejections.<sup>3</sup> It is not necessary that all claims be twice rejected and it is sufficient to confer jurisdiction on the Board if any claim in the application satisfies this requirement. It is also not necessary that the rejection occur during prosecution of a single application, and it is sufficient if one claim is rejected both in a prior application and in a continuing application.<sup>4</sup>

The patent regulations thus permit Applicants the opportunity to obtain a final disposition of the patentability of their patent claims by appealing the Examiner's rejections prior to reaching a "final" impasse with the Examiner. Because Applicant has the choice to continue *ex parte* prosecution or pursue the appeal route, the decision should take account the strength of the claims and arguments in view of the cited art and whether the claims are in their best possible form prior to entering the appeal process.

## II. TO AMEND OR TO APPEAL: THE *FESTO* FACTOR

Given the option of 1) appealing a final rejection or a second non-final rejection or 2) pursuing prosecution on the merits by the filing of an Amendment or Response, an Applicant would be well-advised to press matters for patentability of the *originally filed* claims as far as possible before the Examiner. The Supreme Court's 2002 decision in *Festo* emphasizes the importance of appealing a rejection that Applicant views as patently incorrect as opposed to amending the claims in a response to an Office Action. "While the patentee has the right to appeal, his decision to forgo an appeal and submit an amended claim is taken as a concession that the invention as patented does not reach as far as the original claim."<sup>5</sup> When a claim is amended and narrowed whether for purposes of complying with a prior art rejection under 35 U.S.C. § 102 or § 103 or for purposes of clarifying the claim meaning under 35 U.S.C. § 112, the patentee is regarded as "having conceded an inability to claim the broader subject matter or at least as having abandoned the right to

<sup>3</sup> 37 C.F.R. § 1.191 (2000). The Rule further sets forth that for *ex parte* reexamination filed under Rule §1.510 for a patent that issued from an original application filed on or after November 29, 1999, no appeal may be filed until the claims are finally rejected.

<sup>4</sup> Manual of Patent Examining Procedure (hereafter "MPEP") §1205 (2002).

<sup>5</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S. Ct. 1831, 1840; 62 U.S.P.Q.2d (BNA) 1705, 1711 (2002).

appeal a rejection. In either case estoppel may apply."<sup>6</sup> The Supreme Court establishes amendment and appeal as opposite paths to be taken. Abandonment of the right to appeal, i.e. amending the claims, is taken as a strong concession. As a result of *Festo*, Applicants who amend claims without any explanation do so at their peril: "[W]hen a court is unable to determine the purpose underlying a narrowing amendment – and hence a rationale for limiting the estoppel to the surrender of particular equivalents [under the doctrine of equivalents]— the court should presume that the patentee surrendered all subject matter between the broader and narrower language."<sup>7</sup>

The *Festo* decision equates amendment with a surrender of the right to appeal, and that estoppel or surrender of equivalents arises from such amendment. This suggests that if the rejection of a broad independent claim is appealed, rather than amended, then estoppel may not apply or perhaps a less stringent estoppel may apply even if the claim is ultimately deemed unpatentable on appeal, because Applicant has not acquiesced to the Examiner's rejection. In view of the Federal Circuit precedent, during *ex parte* practice, an Applicant who can make a colorable argument of patentability over prior art without amending the claims should proceed to make such arguments. This approach should be taken even though amendatory material would strengthen the arguments. Such an Applicant will not have been deemed to have acquiesced in the rejection and not surrendered a wide swath of equivalents between the original and amended claim. As a safeguard, amendatory material can be placed in a separate dependent claim to test whether the amendatory material would be deemed to describe allowable subject matter.

Aside from the issue of scope of equivalents addressed by the Supreme Court, the Federal Circuit case law on dedication also suggests that narrowing claim amendments are a form of conscious waiver.

The patentee has control over the drafting of the claims, and if he discloses but omits to claim certain subject matter, he will be held to have waived the right to capture the disclosed matter under the doctrine of equivalents, and to have dedicated it to the public. No such waiver occurs where, as in *GraverTank II*, the

<sup>6</sup> 122 S. Ct. at 1840; 62 U.S.P.Q. (BNA) at 1712.

<sup>7</sup> 122 S. Ct. at 1842; 62 U.S.P.Q.2d (BNA) at 1713.

patentee actually claimed the subject matter, even if the particular claims are later held invalid. There is, moreover, in such circumstances far less possibility that the patentee is "gaming" the system, that is, deliberately writing narrow claims with the objective of avoiding a searching PTO examination and recapturing the disclosed subject matter through the doctrine of equivalents.

In view of the negative consequences of failing to argue patentability to the fullest extent and pitfalls of dedication if broad claims are amended to exclude particular embodiments, it behooves an Applicant to strenuously fight any patentability rejections without amendment, if possible.<sup>8</sup>

### III. EVALUATING WHETHER TO APPEAL A REJECTION

Over the course of *ex parte* prosecution, the Applicant should continually evaluate the strength of the Examiner's rejection not only on the technical points underlying the rejection, but also the procedure applied in making the rejection and the rationale used to maintain any rejections. This evaluation will provide a better informed decision on whether an Appeal should be pursued.

In the event of a second non-final rejection under 35 U.S.C. § 102 or 103 in view of newly applied art, it is beneficial to respond to the rejection under 37 C.F.R. § 1.111. In view of such a non-finality, the Applicant still has the opportunity to obtain allowance of the claims in a timely manner without incurring the expense and time delays of an appeal. The most recent available figures from the U.S. Patent Office indicate that the Board of Patent Appeals is currently deciding appeals filed up to three years ago.<sup>9</sup> The opportunity to respond again under

<sup>8</sup> Johnson & Johnston v. R.E. Service Co., 285 F.3d 1046, 1060; 62 U.S.P.Q. (BNA) 1225, 1235 (Fed. Cir. 2002) (concurring opinion reconciling applicability of equivalents in *Graver Tank* and inapplicability of equivalents in the subject case).

<sup>9</sup> With the exception of a limited number of appeals involving special circumstances, the Board of Patent Appeals and Interferences is currently deciding appeals received at the Board as follows:

|            |                  |
|------------|------------------|
| BIOTECH    | Fiscal Year 2000 |
| CHEMICAL   | Fiscal Year 1999 |
| ELECTRICAL | Fiscal Year 2000 |
| MECHANICAL | Fiscal Year 2002 |
| DESIGN     | Fiscal Year 2002 |

These statistics were obtained from the U.S.P.T.O. website at [www.uspto.gov/web/offices/dcom/opa/baiproducton.xls](http://www.uspto.gov/web/offices/dcom/opa/baiproducton.xls).

Section 1.111 also affords the opportunity to develop the record further, which leads to either of two possible benefits.

As a first possibility, the Examiner will accept the arguments in the response as being sufficiently persuasive to place at least some of the claims in condition for allowance. At that juncture, the Applicant has the additional option of amending the claims to obtain allowance of some claims and filing a separate continuation application for any claims that remain rejected. As a second possibility, the Examiner will reject the arguments in the response as not being persuasive, but expand upon the rationale as to the lack of persuasiveness in a subsequent non-final or final rejection. The value of the second possibility necessarily relies on the nature of the response filed by the Applicant. This makes it very important to exercise precision in formulating the response rather than stating generalities. General denials submitted by the Applicant merely begot general denials from the Examiner, which is not helpful towards advancing a dialog with the Examiner, obtaining the patent or developing the record for appeal. For these same reasons, an Applicant should respond to a final rejection under 37 C.F.R. § 1.116 using the same strategy. In particular, for any Response to Arguments made by the Examiner, the Applicant should assess the underlying rationale and explain any weaknesses or inconsistencies in the Examiner's position.

Arguments directed towards patentability over prior art fall generally into two broad categories, technical arguments and legal arguments. Both types of arguments should be developed in responses filed under 37 C.F.R. § 1.111 and 1.116 prior to entering the appeal stage.

### A. ANALYSIS OF RECENT DECISIONS

The decisions of the Board of Patent Appeals and Interferences dating from appeals filed during Fiscal Year 1993 are available through the U.S.P.T.O. website at [www.uspto.gov/web/offices/com/sol/foia/index.html](http://www.uspto.gov/web/offices/com/sol/foia/index.html). The database is searchable, through somewhat limited search constraints, at [www.uspto.gov/web/menu/search/html](http://www.uspto.gov/web/menu/search/html). A random sample of the decisions indicates that legal and technical arguments are equally effective in reversing Examiner rejections.<sup>10</sup>

A review of a number of recent Board Decisions reveals several analyses that are noteworthy. These particular decisions offer some

<sup>10</sup> The database of opinions runs several thousands in number. Approximately 200 decisions were reviewed in this assessment.

insight on "claim construction" approaches that have been taken by various panels, compares and contrasts effective arguments based on technical distinctions and legal arguments. It is noted that most, if not all, of the decisions posted to the website and all those discussed below are identified as "non-precedential" decisions that are not binding on the Board. If any weight is given to such decisions, the weight is severely limited.<sup>11</sup> However, in certain circumstances, the Federal Circuit which reviews appeal decisions of the Board, will give some weight to decisions designated as non-precedential.<sup>12</sup> For purposes of fashioning or evaluating arguments for purposes of appeal, a brief discussion of selected decisions follow.

#### 1. Claim Interpretation Of Rejected Claims

In analyzing prior art rejections, Board decisions that address claim interpretation rely upon two seemingly opposite lines of legal precedent. Recent panels, following the mandate of the Supreme Court in *Markman v. Westview Instruments, Inc.*,<sup>13</sup> resort to Applicant's disclosure for purposes of interpreting the claims.<sup>14</sup> This appears to be contrary to the concept that during prosecution, the claims are to be given their broadest reasonable meaning and the scope of the claim cannot be narrowed by reading disclosed limitations in to the claim.<sup>15</sup> Several decisions of the Board do in fact resort to the specification and drawings for purposes of understanding the scope of a rejected claim.

Even though the panels have turned to the specification to interpret claims on appeal, any Applicant deciding whether to pursue an appeal

<sup>11</sup> See *Ex parte Theurer*, Appeal 96-2142 stating:

Unpublished (or non-precedential) opinions of the Federal Circuit are not precedent in the Federal Circuit and will not be cited, considered or regarded as precedent by the EIC, the Board or any other tribunal within the Patent and Trademark Office.

<sup>12</sup> An opinion or order which is designated as not to be cited as precedent is one unanimously determined by the panel issuing it as not significantly adding to the body of law. Any opinion or order so designated must not be employed or cited as precedent. This rule does not preclude assertion of claim preclusion, issue preclusion, judicial estoppel, law of the case or the like based on a decision of the court designated as non-precedential. Rules of the Court of Appeals for the Federal Circuit, Rule 47.6(b).

Federal Circuit Rule 47.6(b) does not unconditionally prohibit citation of non-precedential opinions but instead permits citation of opinions for limited purposes. *Burke, Inc. v. Bruno Indep. Living Aids, Inc.*, 183 F.3d 1334, 1337; 51 U.S.P.Q.2d (BNA) 1295, 1297 (Fed. Cir. 1999). See also *Anastaff v. United States*, 223 F.3d 899-905 (8th Cir.) (holding that unpublished decision have precedential effect) *vacated* 99-3917, 2000 WL 1863092 (8th Cir. 2000).

<sup>13</sup> 116 S.Ct. 1384; 38 U.S.P.Q.2d (BNA) 1461 (1996).

<sup>14</sup> *Ex parte Horsmann*, 1997-3241.

<sup>15</sup> *In re Morris*, 127 F.3d 1048, 1054; 44 U.S.P.Q.2d (BNA) 1023, 1027 (Fed. Cir. 1997).

based on existing claim language or whether to continue prosecution by one of several non-appeal alternatives discussed below, should consider whether their particular arguments can be supported by the *context* and broad *concepts* of the pending claim recitations. In such a case, it is possible that the broad concepts of the claim can be argued on appeal without modifying the claim language to specifically include the limitations in the specification. However, if the arguments must rely on actual limitations discussed in the specification but are unclaimed, then the Applicant would be better advised to amend the claim to describe the invention more specifically.

#### A. CONCEPTUAL DISTINCTIONS BASED ON CONTEXT

In *Ex parte Schmidt*, 94-4239, the claim in question recited:

1. An extended field-of-view mirror, the mirror comprising:
  - (a) a convex reflective surface having a viewing area and a continuous perimetral edge surrounding the viewing area;
  - (b) an *opaque band integrally formed* with the reflective surface and depending therefrom, the opaque band substantially surrounding the entire reflective surface; and
  - (c) a mounting flange *integrally formed with* the opaque band and extending outwardly therefrom. (Emphasis added)

A central issue in the appeal was how to define the broad recitation "integrally formed with." The Board recognized that the specification provided no definition of the term, but turned to Fig. 4 of the application to determine that in the context of claim 1, "integrally formed with" meant that the mirror parts were joined together prior to any use of the mirror. In essence, the mirror included each of the cited components prior to its being secured to a mounting frame. In reversing the rejection, the Board noted that the cited art did not include the claim elements "integrally formed with" since a separate elastic ring was only part of the disclosed structure after being put into an interlocking relationship with a frame. The cited ring was thus "separate" and not integrally formed with the mirror prior to any use. The decision and definition of the phrase "integrally formed with" appears to have put significant weight on the context established by the claim preamble. In particular, it was "a mirror" that included several elements "integrally formed with" other elements. It is conceivable that a different outcome

would have resulted on appeal if the claim recited a "mirror assembly" rather than just a "mirror."<sup>16</sup>

The Board also resorted to Applicant's specification for claim construction purposes in *Ex parte Rahman*, 2001-1480. While acknowledging that claims should be given their broadest-reasonable interpretation during prosecution, the Board further indicated that the terms in the claim should be construed as those skilled in the art would construe the claim.<sup>17</sup>

In *Rahman*, the claim in question recited:

A method for controlling traffic comprising:  
developing global positioning system information about a plurality of vehicles;  
analyzing traffic patterns based on said information;  
developing traffic control signals based on said traffic patterns; and  
transmitting said traffic control signals to *traffic control devices*. (Emphasis added).

Based on descriptions in the specification, the Board construed "traffic control devices" to comprise devices such as speed limit signs, traffic metering lights, traffic signs and traffic signals. The cited art disclosed transmission of route information to a microcontroller located on a vehicle. The Board considered that the transmission of traffic information to a vehicle was not a transmission of traffic control signals to "a traffic control device."

Under its broadest construction, the term "traffic control device" may comprise any device that would have an impact on traffic. It is not inconceivable that a controller in a vehicle would have some impact on traffic flows. Yet, in reversing the rejection, the Board's analysis appears to import definitional aspects of the term "a traffic control device" into the claims to limit the phrase to those listed in the specification. Obviously, given the Federal Circuit's directive in *In re Morris* and *In re Hiniker Co.*,<sup>18</sup> that emphasizes the importance of claim language rather than resort to the specification, an Applicant cannot be assured that the Board will use the specification so liberally in the appeal of any given

<sup>16</sup> The claim was rejected by the Board under 37 C.F.R. § 1.196(b), and that the subject claim was issued in U.S.P. 6293,679 with substantive changes to the claim recitations.

<sup>17</sup> Citing *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986; 6 U.S.P.Q.2d (BNA) 1601, 1604 (CCPA 1977).

<sup>18</sup> *In re Hiniker*, 150 F.3d 1362, 1369; 47 U.S.P.Q.2d (BNA) 1523, 1529 (Fed. Cir. 1998).

case. However, the context of the claim recitation in *Rahman* also suggests that "vehicles" recited in the first element of the appealed claim are being distinguished from "traffic control devices" recited in the last element. Therefore, apart from the definitions imparted by the specification, the claims themselves would appear to warrant the construction afforded by the Board that a "traffic control device" is distinguishable from a "vehicle."<sup>19</sup>

## 2. Patentability Of Invention Based On Achieved Effects Over Prior Art

In some decisions reviewed for the preparation of this article, the panel did not specifically rely on the definition of a claim term in deciding the case. Rather, the rationale underlying reversal of the appealed rejections were cast in terms of the Applicant's discovery and solution of a new problem.

In *Ex parte Nella*, 1998-2753, the rejected claim recited:

A target detection, seeking and guidance system for an air-to-air, air-to-ground and/or ground-to-air missile comprising:  
a hyperspectral imaging system for detecting a target having a predetermined hyperspectral signature;  
means for enabling the missile to track the target matching the predetermined hyperspectral signature; and  
means including a missile controller for guiding the flight path of the missile to intercept the flight path of the target matching said predetermined hyperspectral signature.

The primary reference was directed generally towards missile guidance systems without specifically indicating that the targets were tracked by a hyperspectral signature. Three secondary references did teach hyperspectral imaging for scanning earthbound features such as mineral and vegetation deposits and for oceanographic and agricultural applications. The Examiner had deemed such earth-bound targets as corresponding to the "targets" in the claims. The claims themselves did not define what comprised "targets," and in reversing the rejection, the panel also did not specifically define what comprised a "target." Rather, the panel determined that reviewing the cited references, one skilled in the art would not have been motivated to combine the teachings in the manner proposed by the Examiner.

<sup>19</sup> The Board set forth a new ground of rejection under 37 C.F.R. § 1.196(b). The patent issued as U.S.P. 6,247,113 without any substantive amendment to the appealed claim.

First of all, there is no mention in any of the three secondary references of utilizing hyperspectral imaging for a missile firing system. Cuts teaches utilizing hyperspectral imaging from a vehicle in space to scan the earth for the purpose of identifying mineral or vegetative types. While the appellants have acknowledged that the system disclosed in Davies would be "suitable for use" in the claimed missile system, the reference does not mention such use, suggesting only that the system be used in "earth monitoring satellites" such as oceanography, mapping and mineral exportation, for example. The only uses suggested in the Lurie reference are in space borne cameras that monitor environmental and agricultural situations. Second, the claims before us on appeal all require that the system detect, track and guide a missile based upon the "predetermined hyperspectral signature of a target of interest" which, as we understand the teachings of the applied references, is not the manner in which these systems operate. *Third, none of the applied references recognize the problems to which the appellants' invention are directed, namely, providing a target tracking system for missiles that provides a high degree of recognition and is immune to countermeasures.* (Emphasis added.)

The decision in the *Nella*<sup>20</sup> case has obvious benefits to the Applicant since it does not resort to any definition of what comprises a "target." Cf. *Rahman*, construing claim term "traffic control devices" to have particular meaning in comparison to devices taught in prior art.

As a second example, in *Ex parte Abbott*, 1997-2834, the claim recited a structure for a corrosion resistant lead frame for an integrated circuit which included, *inter alia*:

an isolation layer disposed upon said base metal layer and having a second standard reduction potential, said second standard reduction potential being greater than said first standard reduction potential....

In the decision, the Board noted that Applicant's specification provided an example of the isolation layer as comprising a palladium/nickel alloy layer. However, in reversing the rejection, the isolation layer was not specifically defined by reference to such materials. Rather, the panel stated more generally "the problems to be solved and/or the solutions to the problems in the Levine patents are different from that of the present invention." In addition, in reversing the prior art rejection, the decision further explains "Since [the cited art] is

<sup>20</sup> *Nella* at pages 6-7.

concerned with a different problem relative to the claimed invention and thus a different solution, we agree with the appellant that the combined teachings of the admitted prior art and Levine '067 cannot render the subject matter of the appealed claims to be unpatentable within the meaning of 35 U.S.C. § 103."<sup>21</sup>

The case law is replete with the general concepts that references need not be directed to the same problem as an invention in order to render a claim unpatentable<sup>22</sup>; that the references themselves need not expressly teach each and every claim feature to provide motivation for a modification<sup>23</sup>; that intended use of a particular element does not confer patentability<sup>24</sup>, and that to comprise analogous art, a reference need not be pertinent to every problem with which Applicant is involved<sup>25</sup>. This case law liberates the Examiner to apply and combine prior art that may seem unrelated to the invention at hand. The wide swath of available art and rationale for their combination limits the amount of ground that Applicant can truly proclaim as new and unobvious. Therefore, there appears to be a great legal hurdle against the likelihood that an argument that the Applicant discovered a problem and solution therefor would be successful. Nevertheless, if at all feasible, arguments on appeal should address this matter of Applicant's discovery of a solution to a new problem since the benefits are so numerous. Primarily, the claim may be passed to issuance without the Board making any pronouncements in the file history on the definition of any claim term. In addition, there will be a pronouncement in the file history that Applicant was the first to identify a problem and solution. This is a strong factual component that would favor conferring "pioneer" status on the patent and a greater scope of equivalents.<sup>26</sup>

As a corollary, while the above two examples in *Nella* and *Abbott* pertain to an effect achieved by the invention over the cited art, it is

<sup>21</sup> *Abbott* at page 7.

<sup>22</sup> *Ex parte Levengood*, 28 U.S.P.Q.2d (BNA) 1300, 1302 (BPAI 1993); *In re Kemps*, 97 F.3d 1427 1430; 40 U.S.P.Q.2d (BNA) 1309, 1311 (Fed. Cir. 1996).

<sup>23</sup> *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d (BNA) 1956 (Fed. Cir. 1988).

<sup>24</sup> *Pitney Bowes, Inc. v. Hewlett Packard Co.*, 182 F.3d 1298, 1305; 51 U.S.P.Q. (BNA) 2d 1161, 1165 (Fed. Cir. 1999).

<sup>25</sup> *Ex parte Gaechter*, 65 U.S.P.Q.2d (BNA) 1690, 1692 (BPAI 2002) (unpublished).

<sup>26</sup> *Sun Studs, Inc. v. ATA Equip. Leasing, Inc.*, 872 F.2d 978, 787; 10 U.S.P.Q.2d (BNA) 1338, 1346 (Fed. Cir. 1989) (indicating that pioneer status is a question of fact) but see *Augustine Medical, Inc. v. Gaynor Indus.*, 181 F.3d 1291, 1301, 50 U.S.P.Q.2d (BNA) 1900, 1907 (Fed. Cir. 1999) (indicating that the USPTO and the courts cannot predict the future of whether any invention will open wide vistas of innovation).

important to note that the effect is actually described by the claim language. In *Nella*, the claim actually described guiding a missile according to a "flight path" of the target. Therefore, the conceptual difference between the claimed "target" and the earthbound targets in the references was fairly recited in the claims. Similarly, in *Abbot*, the relative "standard reduction potential" of the isolation layer was also described by the claims themselves, such that conceptually the claims were distinguishable over the prior art. In contrast to the above examples, panels also consistently *affirm* rejections where the Applicant argued that the invention achieved a particular effect over the prior art. However, in those cases where the rejection was affirmed, the claims were silent as to the purported improved effect.<sup>27</sup>

### 3. Semantic Distinctions Based On Definitions

Additionally, following the widespread use of dictionaries in claim construction exercises by the Federal Circuit,<sup>28</sup> the Board of Patent Appeals also turns to dictionary definitions in determining whether rejections are sustainable. In *Ex parte Abe*, 1997-2212, the claim included a "second step for decompiling the machine program, thereby producing a second high-level language source program which does not depend on any architecture...." The panel recognized that neither the specification nor the file history defined the term "decompiling" and thus relied upon a technical dictionary to ascertain the scope of the claim. In so doing, the Board determined that the cited art did not include a step for decompiling which was independent of a particular architecture, but in fact provided an opposite step of recompiling a program into an architecture dependent form. Accordingly, the Board reversed the pending rejections.

In similar manner, in *Ex parte Goumaz*, 1997-2296, the panel referred to a technical dictionary to determine the meaning of the claim term "charge amplifier." There, the Board determined that amplification required a component to increase the strength of a signal without

<sup>27</sup> See *Ex parte Cameron*, 1996-2199 (affirming rejection when Applicant argued that claimed invention exhibited a hysteresis effect that was not claimed in the independent claims); *Ex parte Abbey*, 96-0849 (affirming rejection premised on unclaimed "Venturi" effect); *Ex parte Achter*, 96-0760 (affirming rejection when speed and continuity of operation of device was not claimed by Appellant).

<sup>28</sup> *Inverness Medical Switzerland GmbH v. Warner Lambert Co.*, 309 F.3d 1373, 1378; 64 U.S.P.Q.2d (BNA) 1933, 1936 (Fed. Cir. 2002) citing *Vitronics Corp. v. Conceptomic, Inc.*, 90 F.3d 1576, 1582; 39 U.S.P.Q.2d (BNA) 1573, 1576 (Fed. Cir. 1996).

appreciably altering its characteristic waveform. During *ex parte* prosecution, the Examiner had continually relied upon a storage capacitor as corresponding to the claimed charge amplifier. The Board noted that the passive capacitor cited by the Examiner could not correspond to the claimed amplifier.

Of course, the Board's use of dictionaries also can have the opposite effect and lead the panel to affirm a rejection. In *Ex parte Aboaf*, 1998-0261, a claim recited a type of recording head, and the outcome of the appeal turned on the proper construction of the term "modules" appearing in the claim. The panel determined that "module" is a broad and non-specific term, generally defined with respect to electronic apparatus as a "packaged functional assembly of electronic components for use with other such assemblies." *Webster's Ninth New Collegiate Dictionary*, 1990." The panel noted that the specification referred to a particular arrangement of read and write heads to make up "modules" but that the claims were not so limited. The non-specificity of the term "module" was also used throughout the cited art to identify different groupings of elements, other than those specifically identified by the Applicant. Therefore, the rejection was affirmed in part because no distinction could be made based on the general term "module."

In the decisions discussed above, the Examiner seasonably challenged any construction being argued by Applicant during the course of prosecution. In an instance where the Examiner offers no construction that is broader than that offered by Applicant, this should be pointed out in the Appeal Brief. See *Ex parte Abdelmonem*, 95-4609. In the *Abdelmonem* appeal, the panel acknowledged that the claim recitation at issue was very broad and subject to varying interpretations. However, the Examiner had never indicated that the claim step was being interpreted in making the rejections in a way that differed than that set forth by Applicant. Therefore, the Applicant's interpretation prevailed, without the panel relying on embodiments in the specification for claim interpretation purposes.

As a final note on the use of dictionaries during appeal proceedings, the Board has been known to use a dictionary to determine the definition of a term used in a *cited reference* to determine whether an appealed claim reads on the applied art.<sup>29</sup>

<sup>29</sup> *Ex parte Baccini*, 95-5066.



In view of the foregoing, an Applicant that is relying on definitional aspects of certain claim terms as a basis for distinguishing rejected claims from cited art would be well advised to consider 1) whether the Examiner has considered a broader definition in construing a claim term that is supportable; 2) whether the context of the claim recitation supports the reading being advocated; 3) whether the plain meaning either by a common dictionary or a technical dictionary results in a broader construction that would make the rejected claim readable on the applied art; and 4) whether a term used in a cited reference, while different from Applicant's terminology, nonetheless can be construed to have the same meaning either under a common or technical dictionary definition.

#### 4. Claim Interpretation For Section 112 Rejections

In decisions relating to a rejection under 35 U.S.C. § 112, second paragraph, various panels have relied on the specification to determine whether Applicant has claimed the invention with sufficient clarity. See e.g. *Ex parte Ohira*, 1999-0608; *Ex parte Ruck*, 1998-0515; *Ex parte Babel*, 1997-2977. Federal Circuit precedent gives clear direction that construction of the claim for purposes of clarity is charged to the examination process. "An essential purpose of patent examination is to fashion claims that are precise, clear, correct and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."<sup>30</sup> The test for indefiniteness under Section 112, second paragraph, is whether the claim language when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct.<sup>31</sup>

Despite the liberal use of the specification in determining claim precision, many rejections under 35 U.S.C. § 112, second paragraph, are affirmed. In the *Ohira* and *Babel* appeal decisions, the panel had to determine whether the modifiers "substantial" and "substantially" rendered the claims indefinite. In each instance, the panel determined that the claims were indeed indefinite for including these modifiers. The result is somewhat surprising because the MPEP expressly permits latitude in use of relative terminology in claim language, including the

<sup>30</sup> In re Zletz, 893 F.2d 319, 322; 13 U.S.P.Q.2d (BNA) 1320, 1322 (Fed. Cir. 1989).

<sup>31</sup> In re Merat, 519 F.2d 1390, 1396; 186 U.S.P.Q. (BNA) 471, 476, (CCPA 1975).

use of the term "substantially."<sup>32</sup> It is noted that both in *Ohira* and in *Babel*, the panel found that the specifications gave no specific definition of what comprised a "substantial" amount of the characteristic in question. Therefore, unlike the cases discussed in the MPEP, the specification did little to inform one skilled in the art the precise nature of the claim scope.

As an additional claim construction exercise for purposes of Section 112, second paragraph, the Board may also consider whether the terminology in question has a particular meaning to one skilled in the art by examining prior art references. In *Ex parte Takaku*, 2000-0156, Appellant presented prior art not relied upon the Examiner to demonstrate that physical characteristics of transparency would be understood by one skilled in the chemical vapor deposition art.

#### 5. Legal Arguments

The above discussions relate primarily to technical assessments based on the teachings of the prior art in comparison with appealed claims. The second major category of argument is the legal argument. Legal arguments redirect the emphasis towards the Examiner's improper application of references as set forth in MPEP. Focusing a response and appeal on the weaknesses in Examiner's rationale rather than on the actual technical teachings forces the Examiner to reveal more of his thought processes. This will help Applicants understand the Examiner's arguments, identify weaknesses of the claims, and shore up any such weaknesses prior to appeal. Focusing on the Examiner's rationale during *ex parte* prosecution also has the benefit of avoiding the inadvertent limiting of claims based on express representation of what the claimed invention "is" and "is not" in comparison to the applied art. This reduces the impact of file history estoppel in the case.

##### A. LACK OF INHERENCY IN CITED ART

A review of sample cases suggests that contemporary panels are not inclined to rely on purported implicit teachings in a reference to affirm a rejection. The hesitancy to find inherent disclosures in prior art references applies to both 1) structural features that are claimed and 2) resultant effects that are claimed. The structural features include, for example, attributes of shape of a particular element *Ex parte Turos*,

<sup>32</sup> MPEP 2173.05(b) citing In re Nehrenberg, 280 F.2d 161; 126 U.S.P.Q. (BNA) 383 (CCPA 1960); Andrew Corp. v. Gabriel Electronics, 847 F.2d 819; 6 U.S.P.Q.2d (BNA) 2010 (Fed. Cir. 1988).

2002-0022 (applied art for a shoe cleat did not inherently teach annular ring encircling a hemispherical chamber); the ratios of dimensions for deciding placement of claim elements *Ex parte Uchida*, 1999-0555; the carbon bonding in a chemical structure *Ex parte Sampath*, 1999-2173 (compound containing percentage of carbon in bound state did not require carbon bonding with molybdenum to form molybdenum carbide precipitates); and the presence of close-boiling of non-aromatics *Ex parte Nacamuli*, 1998-1067.

Claimed effects include whether a rubber material is suitable for use as an "eraser" *Ex parte Rudduck*, 1999-2186 (Appellant submitted expert declaration to support position that not all rubber substances act as an eraser); whether a component is operable in a "push on, pull off" fashion *Ex parte Qiao*, 1999-2371 (indicating that Examiner's conclusion that a fastener can be disengaged by pulling is merely speculation); and whether a hanger is rotatable about a post *Ex parte Olsen*, 1999-1044.

It is noteworthy that the cases that reverse rejections based on inherency appear generally to be of more recent vintage. The concept of the lack of inherency argument is not a new one.<sup>33</sup> However, the Federal Circuit's decision in *In re Robertson* appears to have given new strength to this legal argument.<sup>34</sup> "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'"<sup>35</sup> In view of the prevalence of reversals of rejections on grounds of lack of inherency of claim elements in applied art, the record should be carefully developed with regard to any viable inherency positions.

#### B. MOTIVATION TO COMBINE

The argument for teaching away from particular combinations of references has proven to be a common basis for reversing rejections under 35 U.S.C. § 103. In *Ex parte A. Said el Shami*, 93-3369, the claim for a diagnostic device for biological samples recited, in relevant

<sup>33</sup> See *In re Oelrich*, 666 F.2d 578; 212 U.S.P.Q. (BNA) 323, 326 (CCPA 1981).

<sup>34</sup> 169 F.3d 743, 745; 49 U.S.P.Q.2d (BNA) 1949, 1951 (Fed. Cir. 1999).

<sup>35</sup> *Id.* (Internal citations omitted.)

part, "a specific antibody binder covalently immobilized on said first solid phase support to which an analyte label is pre-reacted to saturate substantially all binding sites on said binder to form a first solid phase specific antibody binder-analyte label complex...." The Board noted that the cited art was not drawn to antibody-analyte complexes and to the extent that any analogies could be drawn, it was clear that the target DNA in the reference did not become saturated as claimed. The saturation of all the binding states in the disclosed probe would disable the DNA hybridization, which was the desired result in the reference. An additional secondary reference also included a similar deficiency since saturation of the binding sites would cause the binding sites to become occupied when the reference relied on site availability for the disclosed device to operate. It is not obvious to modify a prior art device which would lead to an inoperative construction.<sup>36</sup>

The Examiner's motivation for combining references can also be undermined by focusing on the effects of the cited art. In *Ex parte Palulu*, 1999-2068, the Examiner contended that positioning of certain operating switches onto the steering wheel of the vehicle would be obvious to minimize driver distraction from the road. However, the cited reference was operable only when the vehicle is at a stop, in an idling state or in a park position. Accordingly, there is no concern for the driver's distraction as the Examiner had postulated. The panel subsequently reversed the rejection.

Strongly contesting the propriety of combining references either under the principle that the references teach away from their combination, or that the modification or combination would render one reference inoperable for its intended purpose is valuable since as discussed above, it focuses the analysis away from particular definitions in the claim language. Moreover, in the event that it appears that the combination of art does conceptually teach each feature of the claim, then lack of motivation remains an option to traverse the rejection.

#### IV. OPTIONS TO PURSUE IF APPEAL IS NOT PURSUED

As a general rule, *ex parte* prosecution should be exhausted up through receipt of the Advisory Action after Applicant responds to a final rejection. A constructive dialog between Applicant and the Examiner

<sup>36</sup> *In re Gordon*, 733 F.2d 900, 902; 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984).



may lead to an earlier issuance of the patent, while providing rigorous examination of the application. The latter has the benefit of bolstering the strength of the patent upon issuance.

If after a final rejection, Applicant receives an Advisory Action indicating that the arguments of record have not been deemed persuasive for all of the claims, Applicant still has several non-appeal options. A notice of appeal may be filed for reasons other than seeking review of a rejection by the Board. For example, because filing a Notice of Appeal automatically provides a two-month period for filing the brief,<sup>37</sup> many applicants routinely file a notice of appeal as a cheaper alternative to seeking a third month extension of time to respond to a final under § 1.136(a). Under these circumstances, and with the consent of the examiner, prosecution may proceed after filing a notice of appeal.

#### A. AMENDMENT OF CLAIMS

Under 37 C.F.R. § 1.116, after final rejection amendments which cancel claims complying with any requirement of form may be made of right, and amendments for rejected claims to place claims in better form for consideration on appeal may be admitted at the discretion of the examiner.

#### B. AMENDMENT TO OBTAIN ALLOWANCE OF CLAIMS COUPLED WITH CONTINUATION FOR REJECTED CLAIMS

In the case where some claims stand rejected and some claims are allowable, a recommended course would be to amend the allowable subject matter into condition for allowance in the subject application. To avoid or mitigate the effects of estoppel, the Applicant may file a continuation application for the rejected subject matter. The decision in *Haynes International, Inc. v. Jessop Steel Co.*,<sup>38</sup> demonstrates the benefits of pursuing cancelled subject matter in a continuation case. In *Haynes*, the Applicant was successful in obtaining reversal of rejections of certain claims in a parent application during appeal, but unsuccessful in reversing the rejection of another claim, and therefore rewrote subject matter to obtain allowance of the allowed claims. The rejected claim was canceled from the parent case. The Applicant indicated that they could conceivably garner additional technical evidence in support of the patentability of the rejected claim and subsequently filed a continuation

<sup>37</sup> See 37 C.F.R. § 1.192.

<sup>38</sup> 8 F.3d 1573; 28 U.S.P.Q.2d (BNA) 1652 (Fed. Cir. 1993).

application. However, the Applicant did not refile the rejected claim that was previously before the Board and further did not submit any new evidence for patentability in the continuation.

[C]ancellation of the claims [in the parent] did not conclusively establish that Cabot wanted to relinquish coverage of the subject matter encompassed by them, and thus did not necessarily create an estoppel. It is only when the cancellation is considered with the [Applicant's] failure to refile these claims and submit additional test data to support them, it can be said that an estoppel was conclusively established.<sup>39</sup>

*Haynes* suggests that a different case would be presented had the cancellation of rejected claims occurred while prosecution was on-going. Had that been the case, Applicant's purpose in canceling the claims could be divided from that act as a relinquishment of subject matter. *Haynes* also creates a negative inference in not pursuing cancelled subject matter from a parent case in a continuation.

#### C. AMENDMENT OF NON-ALLOWED CLAIMS

The examiner has discretion to enter an amendment placing a case in condition for allowance at any time prior to forwarding the examiner's answer on appeal. However, unless the amendment requires only a cursory review by the examiner, the appellant ordinarily will be expected to comply with 37 C.F.R. § 1.116(c), by showing "good and sufficient reasons why they are necessary and were not earlier presented."

As a practical matter, the Examiner will probably refuse entry of any claim amendment that was not deemed to place the entire application in condition for allowance. However, if Applicant determines that an amendment may persuade the Examiner of patentability, then submission of the amendment would not prejudice Applicant's position during the course of appeal. Non-entered claim amendments will not be interpreted by the Board as an indication that an Applicant is acquiescing in a rejection. An applicant is not estopped from changing his strategy during the course of good faith prosecution before the examiner. A willingness to amend the claims does not prevent appellants from challenging a rejection.<sup>40</sup>

<sup>39</sup> *Haynes* at 8 F.3d at 1578; 28 U.S.P.Q.2d (BNA) 1656.

<sup>40</sup> Ex parte Abdelmonem, 95-4609.

#### D. SUBMISSION OF ADDITIONAL EVIDENCE

The decision whether to admit additional evidence submitted after final rejection is within the discretion of the examiner, unless prosecution is continued under one of the provisions discussed in Section E, below. Unless the additional evidence is submitted in response to a suggestion from the examiner, or is submitted in conjunction with a convincing argument presented in response to the final rejection and clearly places the application in condition for allowance, the examiner is likely to conclude that the new evidence or argument for patentability introduces new issues or requires further substantive consideration, and will not enter the new evidence.

#### E. CONTINUED PROSECUTION IN LIEU OF APPEAL

##### 1. Request For Continued Examination After Final Rejection: RCE

For applications filed after June 8, 1995, the Applicant may request further prosecution on the merits and entry of any un-entered amendments filed under 37 C.F.R. § 1.116.<sup>41</sup> Such a filing withdraws the finality of the Office Action and any submissions will be considered on the merits. The prosecution with the filing of the RCE can include submission of affidavit evidence, IDS materials, in addition to modifications to the specification and claims.<sup>42</sup> The submission may be made after the appeal process commences but must be made prior to a decision on appeal. In this circumstance, the application will be treated as being withdrawn from appeal for prosecution before the Examiner.<sup>43</sup>

##### 2. Continuation Practice

For cases filed between June 8, 1995 and before May 29, 2000, Applicant may file a continued prosecution application, including claim amendments to further describe the invention in view of the applied art.<sup>44</sup> For any application, the Applicant may also file a continuation or continuation-in-part application to define the invention and claims more particularly.<sup>45</sup>

<sup>41</sup> 37 C.F.R. § 1.114

<sup>42</sup> 37 C.F.R. § 1.114(c).

<sup>43</sup> 37 C.F.R. § 1.114(d).

<sup>44</sup> 37 C.F.R. § 1.53(d). The continuation may be filed up until expiration of the time for filing court action following a Decision on Appeal. MPEP 201.1, MPEP 711.02(o); MPEP 1214.06.

<sup>45</sup> 37 C.F.R. § 1.53(b).

#### 3. Transitional Practice

For older cases that have been pending for at least two years as of June 8, 1995,<sup>46</sup> the application is subject to the transitional provisions of 37 C.F.R. § 1.129(a). The applicant or appellant is entitled to consideration of the new amendment, evidence or submission denied entry by the examiner after final rejection, upon payment of the fee under 37 C.F.R. § 1.17(r). This submission must be made prior to filing a Brief on Appeal. It is most important to appreciate that under the GATT amendments, an appellant waives the right to continued examination of claims finally rejected in the same application under 37 C.F.R. § 1.129(a), by filing an appeal brief. Filing an appeal brief therefore terminates the right to a 17-year term in an older application, if it is necessary to file a regular continuing application after the appeal. Any such application will be restricted to a term that expires 20 years from the date of filing the first national benefit application.

#### V. CONCLUSION

Even though the patent statute permits appeal prior to final rejection of the claims, an Applicant should take the opportunity to develop discourse with the Examiner to develop arguments and a more detailed understanding of the Examiner's rationale. Successful prosecution before the Examiner will likely lead to earlier issuance of the patent because the lengthy appeal process can be avoided. Throughout *ex parte* prosecution, the Applicant should continually evaluate and strengthen his position in terms of technical arguments based on both concepts and semantics in addition to legal arguments. If it is determined that the claims are not in the best possible condition for appeal, several options are available to continue prosecution before the Examiner.

<sup>46</sup> The duration of pendency takes into account an reference made in the application to any earlier filed application under 35 U.S.C. § 120, 121 or 365(c).